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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,255	01/26/2000	Garrett L. Evans	13-029 CS	8321

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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/491,255

Applicant(s)

EVANS ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

EXAMINER'S RESPONSE

1. In response to the RCE filed 1-26-00, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Specification

2. The disclosure is objected to because of the following informalities: The cross-reference to related application should be updated to include the current status (abandoned) of reach prior application.

Appropriate correction is required.

Claim Rejections - 35 USC § 102 & 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-14 are rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention.

Applicant's supplemental disclosure statement filed 7-8-93 states that a discussion was held with the ODOT more than a year prior to the filing of the parent application resulting in the building of "the claimed invention" for ODOT more than a year prior to the filing date of the instant application, but less than a year from the filing of the parent application. Since the initial discussion or offer was more than a year from the filing date, this is considered to be a public use or sale of "the claimed invention" more than a year prior to filing. See MPEP 2133.03.

7. Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Triphone article and Saito (US 4255619).

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The Triphone article discloses a tourist information display with status lights indicating two discrete levels (on and off) that can be updated by a phone call from the subscriber. The subscriber is the lodging provider and is located remotely from the sign which is controlled by a computer in response to the telephone call. Status lights are located on each subscribers' AD Strip and a matching light and code are shown on an adjacent map. The article differs from applicants invention in that it does not specify the interface means, means for recognizing remote commands and steps of storing status, receiving updated information, updating stored status, maintaining a status file in the computer and contacting the display boards with the updated information in claim 1.

Saito discloses an analogous art telephone reservation system with a host computer 10 connected to a plurality of phone lines (31, 14, 38) by modems (30,13) and maintaining a status file for communicated status and status change (update) by modem 15 and adaptor 16 (interface) to be stored in computer 17 and indicated by status lights of display board 20. See the abstract and fig. 1, col. 2 line 51 - col. 3 line 39 and co. 9 line 55 - col. 12 line 20.

Regarding claims 1-13, it would have been obvious to one of ordinary skill in the art at the time the invention was made

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to have included in the invention of the Triphone article the interface and status storage/update steps of disclosed in analogous art by Saito because this allows simultaneous communication with a plurality of locations to indicate current (updated) status. Regarding claims 2-3, and 8-9, the commands of Saito are input by a caller or operator. Regarding claims 4 and 10, the display of Saito may be contacted periodically as suggested by the use of time division communication channels. Regarding claims 5 and 11, the data stored in host computer may be considered a log filed. Regarding claims 6 and 12, the information of Saito is stored for display to an operator.

8. Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Triphone article and Saito (US 4255619) as applied above and further in view of Fritts (US 3614727).

Fritts discloses an analogous art changeable highway sign and method communicating commands from a central computer to remote display boards for indication speed limits and current driving conditions such as weather alerts. See the abstract and cols. 1-3. If road alert conditions are not clear from the combination applied above then such would have been obvious in view of the displays indicating driving conditions in Fritts to inform the motorist of driving conditions.

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9. Claims 4 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Triphone article, Saito (US 4255619) and Fritts (US 3614727) as applied above and further in view of Lockwood (US 4359631).

Lockwood discloses a self-service terminal including lodging (hotel) information that is periodically updated by phone line from a remote command center. See the abstract and col. 3. If periodic update is not clear in the combination applied above, then it would have been obvious in view Lockwood disclosing periodic update of travel information such as hotel occupancy so that transitory information remains current.

10. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Triphone article and Saito (US 4255619) and Fritts (US 3614727) as applied above and the Garber (US 4905163).

The combination applied above differs from applicant's claim 14 in that it does not disclose the touch screen or downloading of weather information in claim 11.

Garber discloses an analogous information display system for navigation and travel. The system can download weather information to provide indication of the weather (column 2 lines 35 and 40) at specific locations and includes a variety of input

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devices including touch screens (column 51 line 26). See the abstract and column 2 lines 28-50, column 51 lines 14-29.

Regarding claim 14, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included touch screen taught by Garber in the combination applied above because the touch screen has the advantage of allowing selection directly from a display menu or map without having to locate and use a separate keyboard, mouse, or other input means.

Requirement for Information under 37 CFR 1.105

11. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. Approval by a SPE of this requirement is indicated in the prior Office action (paper number 6) mailed on 7-16-03.

12. An issue of public use or on sale activity has been raised in this application by the supplemental IDS filed 7-8-93 stating that meetings and exhibit/demonstration of the invention was made. This is considered a public use or sale activity and this request is being made to clarify the issue. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. § 102(b), additional information

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regarding this issue is required as follows: It is requested that applicants submit any prior written documents and/or submit evidence in affidavit form explaining specifically if a sale or offer for sale was made in the March, 1992 meeting with ODOT, what features of the currently claimed invention were discussed and pointing out any differences, if any, between what was discussed and the invention claimed in the instant application. The same information is requested with respect to the later meetings. In particular, applicant is requested to submit information regarding any differences between the built and installed display of the type disclosed and claimed in the 08/043,190 application and that disclosed and claimed in the instant application. Applicant is requested to submit any written documents directed to sale, offer for sale and/or public use of the display board including features and differences with the instant claimed invention and including the dates of such activities. Further, in response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.

13. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter

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indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

14. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

15. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

16. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period

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for reply to this requirement coincides with the time period for reply to the enclosed Office action.

CONTACT INFORMATION


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (703) 305-4700 or TC 2600 Customer Service at (703) 306-0377.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH
4/5/04


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
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